UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,465	04/24/2001	Seth Haberman	20429/9-C	5373

28089   7590   09/17/2007
WILMER CUTLER PICKERING HALE AND DORR LLP
399 PARK AVENUE
NEW YORK, NY 10022

EXAMINER
VAN HANDEL, MICHAEL P

ART UNIT	PAPER NUMBER
2623	

NOTIFICATION DATE	DELIVERY MODE
09/17/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
tina.dougal@wilmerhale.com

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/841,465	HABERMAN ET AL.
	Examiner	Art Unit	
	Michael Van Handel	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2007*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19 and 21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/12/2007*.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is responsive to an Amendment filed 6/18/2007. Claims **1-19, 21** are

pending. Claims **1, 16, 19,** and **21** are amended. Claim **20** is canceled. The examiner hereby

withdraws the objection to claim **21** in light of the amendment.

Response to Arguments

1.   Applicant's arguments regarding claims **1-19** and **21**, filed 6/18/2007, have been fully

considered, but they are not persuasive.

Regarding claims **1-18** and **21**, the applicant argues that the claim language "non-

interactive" is supported in Applicant's specification. The examiner respectfully disagrees. The

applicant cites paragraphs 48 and 50 as supporting the claim language; however, the examiner

fails to find any recitation of a "non-interactive" advertisement in the cited paragraphs. The cited

paragraphs state that selection of a commercial segment to play is based on rules in terms of

viewer profiles. The examiner fails to find how this is necessarily indicative of a non-interactive

advertisement. In fact, Applicant's specification discloses a Personalization Engine (PE) that

creates a log of activity and viewing information for customization. This information is

delivered to create profiles in a central server (paragraph 63). The examiner interprets this as

customizing advertisements for a particular viewer based on the particular viewer's interaction

with the system (i.e. viewing activity). As such, the examiner maintains that Applicant's

specification lacks adequate support for "non-interactive" personalized advertisements, as currently claimed.

Regarding claims **1, 16, 19,** and **21,** the applicant argues that Klosterman et al. nowhere describes that a network creates an advertisement template comprising a plurality of slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots. The examiner respectfully disagrees. As noted in the Office Action mailed 12/18/2006, Klosterman et al. discloses systems and methods for allowing a network to set up multiple channels of advertising, e.g., FOX, FOX1, FOX2, etc. Each channel provides a separate program of advertising synchronized in time to coincide with advertising delivered on the main channel, e.g., FOX. For example, the television set of an individual viewer who is watching the SuperBowl on FOX will be automatically tuned, in a manner invisible to the viewer, to one of the multiple FOX channels during a commercial break (p. 2, paragraph 31). Klosterman et al. further discloses that a television set automatically tunes in a serial manner to one or more of the multiple FOX channels (p. 2, paragraph 31). The examiner interprets this as a plurality of different media segments that are insertable into at least one of a plurality of slots in sequence. The examiner further notes that a main television channel with a main program and advertisements is inherently an advertisement template comprising a plurality of slots in sequence, as currently claimed. As such, the examiner maintains that Klosterman et al. meets the limitation of "an advertisement template comprising a plurality of slots in sequence, wherein a plurality of different media segments are insertable into at least one of said slots," as currently claimed.

Further regarding claims **1**, **16**, **19**, and **21**, the examiner acknowledges the applicant's

argument regarding the overlay messages of Klosterman et al.; however, the examiner notes that

Klosterman et al. describes the overlay messages as an example of customizing an advertisement

for a user (p. 6, paragraph 71). Klosterman et al. further discloses automatically tuning in a

serial manner to one or more advertising channels (p. 2, paragraph 31). The examiner interprets

this as " a personalized advertisement template comprising a plurality of media slots in sequence,

wherein as plurality of different media segments are insertable into at least one of said slots," as

noted above.

Still further regarding claims **1**, **16**, **19**, and **21**, the applicant argues Klosterman et al.

does not show or suggest that the receiving unit uses said content selection information to switch

between said plurality of data streams to retrieve at least one of said media segments for each of

said slots to assemble a non-interactive personalized advertisement. The applicant specifically

argues that Klosterman et al.'s viewer profile information is not used by the viewer's terminal to

switch between a plurality of data streams to receive media segments. The examiner notes;

however, that the features upon which applicant relies (i.e., viewer profile information is not

used by the viewer's terminal to switch ...) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are not read

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 112

1.   Claims **1-18, 21** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter, which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention. Specifically, the examiner fails to find a recitation of the subject matter corresponding

to the claimed "non-interactive" in the applicant's specification.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

2.   Claims **1-5, 8, 9, 12, 13, 15, 16, 18, 19, 21** are rejected under 35 U.S.C. 102(e) as being

anticipated by Klosterman et al.

        Referring to claims **1, 16,** and **19,** Klosterman et al. discloses a method/system for

allowing the creation of a plurality of non-interactive personalized advertisements to be viewed

by an intended audience, comprising:

-      creating a personalized advertisement template comprising a plurality of media slots

        in sequence, wherein a plurality of different media segments are insertable into at

        least one of said slots (p. 3, paragraphs 38-40, 42, 44, 45, 48);

- simultaneously transmitting a plurality of data streams to a receiving unit, each data

  stream delivering a different one of said plurality of media segments for said at least

  one of said slots, wherein said media segments are synchronized to begin and end at

  substantially the same time (p. 2, paragraph 31 & p. 3, paragraph 39); and

- transmitting content selection information regarding content of said plurality of data

  streams to said receiving unit, said information including switch times for said

  plurality of synchronized media segments, wherein said receiving unit uses said

  content selection information to switch between said plurality of data streams to

  retrieve at least one of said media segments for each of said slots, (p. 2, paragraphs

  32, 33; p. 3, paragraphs 38-40, 42; & p. 4, paragraphs 44, 45, 48), to assemble a non-

  interactive personalized advertisement (p. 6, paragraph 71).

Further referring to claims **16** and **19**, Klosterman et al. discloses that one of said data streams

transmits content selection information regarding content of said plurality of data streams said

information including switch times for allowing a receiving unit to switch among said plurality

of data streams to select a particular media segment at a particular time (p. 3, paragraphs 38, 39),

to assemble a non-interactive personalized advertisement (p. 6, paragraph 71).

Referring to claim **2**, Klosterman et al. discloses the method of claim 1, wherein said

receiving unit selects among said plurality of data streams in real time (Klosterman et al.

discloses automatically tuning the television set of an individual viewer to one of multiple FOX

channels of advertising during a commercial break, in a manner invisible to the viewer. The

examiner interprets this as selecting among the plurality of channels in real time)(p. 2, paragraph

31 & p. 4, paragraphs 44, 45).

Referring to claim **3**, Klosterman et al. discloses the method of claim 1, wherein said personalized advertisement is viewed by a viewer as it is assembled (p. 6, paragraph 71).

· Referring to claim **4**, Klosterman et al. discloses the method of claim 1, wherein said receiving unit selects among said plurality of data streams based on said content selection information and information about a viewer who will view said personalized advertisement (p. 3, paragraph 40).

Referring to claim **5**, Klosterman et al. discloses the method of claim 4, further including providing a data stream with a default personalized advertisement to allow said receiving unit to display said default personalized advertisement without selecting between said plurality of data streams (the examiner notes that in the SuperBowl example, the beer commercial is the commercial displayed on Channel A with the SuperBowl program. Thus, the examiner interprets the beer commercial to be a default personalized advertisement, as claimed)(p. 4, paragraphs 44, 45).

Referring to claim **8**, Klosterman et al. discloses the method of claim 1, wherein said segments are incomplete parts of a personalized advertisement (the examiner notes that Klosterman et al. discloses preloading advertisement overlay messages into the memories of a viewers' television system. When the advertisement is broadcast, the overlay message is displayed with it. The examiner interprets these advertisements to be incomplete sections of a complete non-interactive advertisement, as claimed (p. 6, paragraph 71).

Referring to claim **9**, Klosterman et al. discloses the method of claim 1, wherein said receiving unit is a set top box (p. 3, paragraph 35).

Referring to claims **12** and **18**, Klosterman et al. discloses the method/system of claims 9

and 16, respectively, wherein said set top box momentarily switches from a first digital data

stream to a second digital data stream to play out a personalized advertisement (p. 2, paragraph

31 & p. 3, paragraphs 35, 40).

Referring to claim **13**, Klosterman et al. discloses the method of claim 9, wherein said set

top box receives a plurality of television channels over said data streams, and said channels

include programs including a synchronized commercial break; and during said synchronized

commercial break, said data streams deliver segments to create a personalized advertisement for

display irrespective of which channel said set top box had selected (p. 2, paragraph 31; p. 3,

paragraphs 38-40, 42; & p. 4, paragraphs 44, 45).

Referring to claim **15**, Klosterman et al. discloses the method of claim 1, further

including a plurality of templates for creating said personalized advertisements, wherein said

templates include video sequence templates and audio sequence templates (the examiner notes

that each channel shows a series of advertisements back-to-back. These advertisements include

video and audio. Since these advertisements can be modified by adding overlays to create a

more personalized advertisement, the examiner interprets the original channel advertisements to

be have video sequence templates and audio sequence templates that are used with the overlay

messages to create more personalized advertisements)(p. 2, paragraph 31; p. 3, paragraphs 38-40,

42; p. 4, paragraphs 44, 45; & p. 6, paragraph 71).

Referring to claim **21**, Klosterman et al. discloses a method for delivering a plurality of

different non-interactive advertisements over a television transmission network, comprising:

- creating a plurality of different video and audio media segments, wherein said different media segments include incomplete sections of a complete non-interactive advertisement (a network can set up multiple channels of advertising, e.g., FOX, FOX1, FOX2, etc. The examiner further notes that Klosterman et al. discloses preloading advertisement overlay messages into the memories of a viewers' television system. When the advertisement is broadcast, the overlay message is displayed with it. The examiner interprets these advertisements to be incomplete sections of a complete non-interactive advertisement, as claimed)(p. 1, paragraph 10; p. 2, paragraph 31; & p. 6, paragraph 71);

- simultaneously transmitting a plurality of television programs to a television signal receiver through one or more data streams, wherein said plurality of television programs have at least one synchronized commercial break (p. 2, paragraph 31 & p. 3, paragraph 39);

- during said synchronized commercial break, transmitting said plurality of different media segments to said television signal receiver through said one or more data streams, wherein all media segments are transmitted simultaneously (p. 2, paragraph 31 & p. 3, paragraphs 38, 39);

- directing said television signal receiver to switch to one of said one or more data streams to retrieve one or more media segments to assemble said complete non-interactive advertisement (p. 3, paragraph 42 & p. 6, paragraph 71); and

- wherein after said synchronized commercial break, said television signal receiver switches to a previously selected television program (p. 4, paragraphs 44, 45).

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claim **6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al.

in view of Ten Kate et al.

Referring to claim **6**, Klosterman et al. discloses the method of claim 1. Klosterman et al.

does not disclose that the plurality of data streams are MPEG encoded data streams. Ten Kate et

al. discloses encoding video streams in MPEG-2 (col. 3, l. 39-41, 61-67). It would have been

obvious to one of ordinary skill in the art at the time that the invention was made to modify the

channels of Klosterman et al. to be MPEG encoded, such as that taught by Ten Kate et al. in

order to achieve a higher compression rate.

3.   Claims **7, 10, 11, 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Klosterman et al. in view of Picco et al.

Referring to claim **7**, Klosterman et al. discloses the method of claim 1. Klosterman et al.

does not disclose that the plurality of data streams are multiplexed into a transport stream. Picco

et al. discloses multiplexing live television feeds 106, local content streams 108 and various

other signals into a digital data stream that is then transmitted to a user (col. 8, l. 56-67 & Fig. 5).

It would have been obvious to one of ordinary skill in the art at the time that the invention was

made to modify the channels of Klosterman et al. to be multiplexed into a digital data stream,

such as that taught by Picco et al. in order to provide individualized local content in a digital

stream by transmitting to the user a single multiplexed data stream (Picco et al. col. 2, l. 42-44).

Referring to claims **10**, **11**, and **17**, Klosterman et al. discloses the method/system of

claims 9 and 16. Klosterman et al. further discloses that the invention can receive analog

television and digital television (p. 3, paragraph 35). Klosterman et al. still further discloses

switching advertisements in response to a channel change command in the vertical blanking

interval (VBI) (p. 3, paragraph 38). Klosterman et al. does not disclose that the set top box

momentarily switches from an analog data stream to a digital data stream to play out a

personalized advertisement triggered by VBI data. Picco et al. discloses a set top box 120 (Fig.

7) that can receive both analog data streams and digital data streams (col. 14, l. 62-67). Picco et

al. further discloses that the set top box 120 activates a web browser in response to a user

selection when the user sees a television advertisement, which references a particular web site

(col. 14, l. 17-41 & Fig. 11). It would have been obvious to one of ordinary skill in the art at the

time that the invention was made to modify the VBI triggered advertisement switching of

Klosterman et al. to include switching from an analog stream to a digital stream to display

advertising information, such as that taught by Picco et al. in order to provide a television viewer

with advertising from the Internet.

4.   Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Klosterman et al.

in view of Kunkel et al.

Referring to claim **14**, Klosterman et al. discloses the method of claim 1. Klosterman et al. does not disclose including transition segments, which are inserted into a personalized advertisement between segments. Kunkel et al. discloses encoding video streams in MPEG1 or MPEG2. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the channels of Klosterman et al. to be MPEG encoded, such as that taught by Kunkel et al. in order to achieve a higher compression rate. Kunkel et al. further discloses sending I-frames continuously at the beginning of targeted ads, so that the set top box tuners can quickly acquire the signal. Similarly, a continuous stream of I-frames is provided for the last few seconds of the advertisement to enable the tuners to quickly reacquire the original channel once the advertisement has concluded (p. 4, paragraph 31). It would have been obvious one of ordinary skill in the art at the time that the invention was made to modify the combination of Klosterman et al. and Kunkel et al. to include continuously sending I-frames at the beginning and end of advertisements, such as that taught by Kunkel et al. in order to facilitate seamless transitions between advertisements and original programming (Kunkel et al. p. 4, paragraph 31).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968.

The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVH

CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600